



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,456	10/30/2001	Jose Costa Requena	944-001.038-1	2266

7590 06/20/2005

Ware, Fressola, Van Der Sluys & Adolphson, LLP
Building Five, Bradford Green
755 Main Street
P.O. Box 224
Monroe, CT 06468

EXAMINER

SIDDIQI, MOHAMMAD A

ART UNIT	PAPER NUMBER
----------	--------------

2154

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,456

Applicant(s)

REQUENA, JOSE COSTA

Examiner

Mohammad A. Siddiqi

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-16 and 22-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/30/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/26/02, 6/11/02.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. Applicant's election with traverse of the invention II, claims 17-21 in the reply filed on 04/07/2005 is acknowledged. The traversal is on the ground that:

Applicant argument are not found persuasive because as mentioned in the previous office action, Following are the criteria for the restriction:

- a) the inventions must be independent or distinct as claimed;
- b) there must be serious burden on the examiner if restriction is required;

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16, drawn to users registering for said presence of service, classified in class 709, subclass 225.
- II. Claim 17-21, drawn to inviting user to exchange contents, classified in class 709, subclass 206.
- III. Claim 22-25, drawn to Instant messaging service, classified in class 455, subclass 466.

2. Inventions I - II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from

each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as lacking inviting user to exchange contents, instant messaging, particulars. See MPEP § 806.05(d).

3. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as lacking instant messaging, particulars. See MPEP § 806.05(d).

4. Because these inventions are distinct for the reasons given above and the search required for each groups is different and not co-extensive for examination purpose.

5. For example the searches for the two inventions would not be co-extensive because these groups would require different searches on PTO's classification and subclass as following ;

- I. The Group I search (claims 1-16) would require use of search class 709, subclass 225 (which would not required for the groups II and III).

- II. The Group II search (claims 17-21) would require use of search class 709, subclass 206 (which would not required for the groups I and III).
 - III. The Group I search (claims 22-25) would require use of search class 455, subclass 466 (which would not required for the groups I and II).
6. In response to applicant's, those three groups of the invention are independent and very distinct as claimed. See paragraphs 2-5 for the explanations. There is a serious burden on the examiner to exam these three inventions in one application.
7. Therefore the restriction requirement is still deemed proper and it is made Final.

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. Claims 17, 18, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Dalal et al. (US 2002/0065894) (hereinafter Dalal).

9. Dalal discloses, System, comprising:

a central server (instant messaging server, page 2, paragraph #0014), responsive to an invitation message from an inviting user to exchange content with an invited user, for providing a presence query (user can initiate instant messaging session, page 1, paragraph #0006); and

a presence server, responsive to said presence query, for providing presence information relating to a registered user (presence server display's the user's presence data, page 2, paragraph #0014), wherein said central server is responsive to said presence information relating to said invited user registered at said presence server (presence server, page 2, paragraph #0016), for use in deciding said content is sent to said invited user, stored or refused (presence server, page 2, paragraph #0016), wherein said presence query and invitation message are communicated according to an application layer control protocol (using protocol, Page 2, paragraph #0016) and wherein said information relating to presence pertains to a spatial location of said registered user (John is online, Page 2, paragraph #0016).

As per claim 18, Dalal Discloses central server is also responsive to said invitation message for providing a subscription query and wherein said system further comprises a messaging server (instant messaging server, page 2, paragraph #0014), responsive to said subscription query, for providing notification information relating to a request from a subscribed user for notification of an event (user can be notified, page 1, paragraph #0009), and wherein said central server is responsive to said notification information for said subscribed user in deciding said content should be sent to said invited user, stored or refused (user preference, subscriber is a user who subscribes Instant messaging, page 2, paragraph #0017).

10. As per claim 21, Dalal disclose information relating to presence and pertaining to said spatial location of said user is communicated as a spatial location payload (John is online, Page 2, paragraph #0016).

Claim Rejections - 35 USC § 103

11. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalal et al. (US 2002/0065894) (hereinafter Dalal) in view of "Official Notice".

12. As per claim 19, examiner takes "official notice" on the concept and use of application layer control protocol is a session initiation protocol (SIP). Because The Session Initiation Protocol (SIP) is an Internet Engineering Task Force standard protocol for initiating an interactive user session that involves multimedia content such as video, voice, chat, gaming, and virtual reality, like HTTP or SMTP, SIP works in the Application layer of the Open Systems Interconnection communications model, the Application layer is the level responsible for ensuring that communication is possible. SIP can establish multimedia sessions or Internet telephony calls, and modify, or terminate them, the protocol can also invite participants to instant messaging sessions that do not necessarily involve the initiator, because the SIP supports name mapping and redirection services, it makes it possible for users to initiate and receive communications and services from any location, and for networks to identify the users where ever they are. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to use SIP protocol with teachings of Dalal. The motivation would have been using industry standard Session Initiation Protocol (SIP).

13. As per claim 20, the claim is rejected for the same reasons as claim 19, above, in addition, Dalal disclose information relating to presence and

Art Unit: 2154

pertaining to said spatial location of said user is communicated as a spatial location payload (John is online, Page 2, paragraph #0016).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U.S Patent 6,463,471 and US 2002/00062345 teaches presence query.

U.S. Patent 5,790,649

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A. Siddiqi whose telephone number is (571) 272-3976. The examiner can normally be reached on Monday -Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MAS



JOHN F. JANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100